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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,669	03/26/2004	Igor Troitski		7835

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IGOR TROITSKI
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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT	PAPER NUMBER
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1742

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/809,669

Applicant(s)

TROITSKI ET AL.

Examiner

George P. Wyszomierski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/26/04</u> | 6) <input type="checkbox"/> Other: _____ |

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1. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not identify the citizenship of inventors Kratt, Seliverstov, or Samarov. While the declaration indicates that these inventors are Resident Aliens in the US, it does not state what country these persons are citizens of. A new oath or declaration specifying the citizenship of Messs. Kratt, Seliverstov and Samarov is required.

3. The cancellation of claims 11-13 in the paper filed October 30, 2006 is noted. The Restriction Requirement issued on October 16, 2006 is moot, as all claims currently pending in the application (1-10 and 14) are directed to a single invention.

4. Claims 1-10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The claims recite numerous features and phrases that lack proper antecedent basis. For example, in claim 1, line 2, "the HIP tooling" lacks antecedent basis. The first time any feature is introduced in a claim, it should be designated as "a" feature, and may subsequently then be referred to as "the" feature. The claims should be revised carefully to eliminate improper phrases.

b) The scope of claim 5 cannot be determined, because not enough information is present to determine the relationship of a thickness of a layer to any machining or material expenses.

c) The first two lines of claim 6 recite "providing the controlled pressure inside the HIP tooling comprising the steps of", but at least several of the steps recited in claim 6 do not appear to be related to providing controlled pressure in the tooling. Only those steps that are necessary to define what is narrower in scope than the process of independent claim 1 should be recited in claim 6 (or any other dependent claim).

d) Claims 1, 6, 7, 8, 9 and 10 do not end with a period, as required when drafting patent claims.

c) Claims dependent upon any claim rejected under this statute are also rejected for the same reasons.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Daam et al. (U.S. Patent 6,482,533).

The Van Daam patent discloses manufacturing a capsule having internal dimensions as desired for a final part, and including hollow inserts (see Van Daam figure 5, feature 50). The parts are assembled together, the capsule filled with powder, and the material is hot isostatically pressed. The pressure used in the HIP step is controlled; see Van Daam column 6, lines 4-21. Finally, the tooling apparatus used is removed, leaving behind a final desired part; see Van Daam column 6, lines 22-42. Thus, all aspects of the invention as claimed appear to be fully met by the disclosure of Van Daam et al.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Daam et al.

The Van Daam patent does not discuss certain specific layer structures or dimensions as recited in claims 3 and 4, or the minimizing of expenses as recited in claim 5. However, the claims in the present case are directed to a method and not to the particular apparatus used to perform such a method, and based on the depictions of the inserts in the drawings of Van Daam, it would appear that using inserts having a geometry as presently claimed would be within the scope of the Van Daam process. With respect to claim 5, clearly one of skill in the art and practicing the process of Van Daam would want to minimize expenses associated therewith. Thus, the presently claimed process is held to have been obvious to one of ordinary skill in the art in view of what is disclosed by Van Daam et al.

9. Claims 6-9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Daam et al., in view of Ritter et al. (U.S. Patent 5,480,468) or Kratt et al. (U.S. Patent 6,210,633).

In addition to what was discussed above, Figure 6C and column 6, lines 10-21 of Van Daam clearly indicates that a vent tube can be attached to the inserts used in that process that will allow HIP gas media to be delivered at a controlled pressure to the interior of the inserts. Claims 7-9 are directed largely to limitations on an apparatus, and such apparatus limitations do not render an otherwise known process patentable.

Van Daam does not disclose the acid pickling step required by the present claims. Ritter column 9, lines 40-41 and Kratt column 6, lines 3-5 indicate that it was known to those skilled in the art, at the time of the present invention, to remove HIP tooling mechanisms by an acid pickling step following the conclusion of HIP.

Therefore, the combination of Van Daam et al., together with the disclosures of Ritter et al. or Kratt et al., renders the invention as presently claimed obvious to a person having ordinary skill in the art.

10. Claims 1-5 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/962147 (which shares at least one common inventor with the present application). Although the conflicting claims are not identical, they are not patentably distinct from each other because while the precise wording of the claims is different in the present application than in the 962147 application, it would appear that performing a process as set forth in the claims of the 962147 application would entail the same set of process steps as recited in the present claims, in the same order and for the same purposes in both instances. Therefore, no patentable distinction is seen between the process as defined in the present claims and that as defined in the claims of the 962147 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. A process which includes the three steps as set forth in claim 10, combined with the other steps required by the claims on which claim 10 depends, is not described or suggested by any of the prior art of record.

13. The remainder of the art noted on the attached forms is considered of interest. This art is held to be no more relevant to the claimed invention than the art applied in the rejections above.

14. The examiner strongly suggests that the Applicants discuss this Office Action with a registered patent attorney or agent prior to responding to this Action. A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster."


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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (571)-273-8300. This Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GPW
January 19, 2007


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1700